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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,361	12/31/2003	Nelson Minar	16113-0761001 GP064-07-US	4924
26192 7590 06/10/2010 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3688	PAPER NUMBER
			NOTIFICATION DATE 06/10/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/750,361	Applicant(s) MINAR, NELSON	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,11-13,17-19,21-25,35-37,42,57-64 and 72-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,11-13,17-19,21-25,35-37,42 and 57-64 and 72-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Interpretation***

1. Note on interpretation of claim terms - Unless a term is given an “explicit” and “clear” definition in the specification (MPEP § 2106.II.C), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification as it would be interpreted by one of ordinary skilled in the art (MPEP § 2111). This means that the words of a claim must be given their “plain meaning” unless the plain meaning is inconsistent with the specification (MPEP § 2111.01.I and 2111.01.III). An explicit and clear definition must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example. An applicant may define specific terms used to describe the invention, but must do so “with reasonable clarity, deliberateness, and precision” and, if done, must “set out his uncommon definition in some manner within the patent disclosure’ so as to give one of ordinary skill in the art notice of the change” in meaning (MPEP § 2111.01.IV and 2173.05(a)).
2. **RSS, Really Simple Syndication** (hereafter **RSS**) and **Atom** are disclosed to be “exemplary syndicated content formats” (para. [0009] of the published application (US 20050165615A1). The spec. does not explicitly and clearly define “syndicated content format”. Indeed, para. [0007] of the published application defines syndicated content formats in terms of **RSS** and **Atom**, so the disclosed definitions are circular.
3. The examiner interprets each **RSS** and **Atom** to be a “name used in trade”, a nonproprietary name by which an article or product is known and called among traders or workers in the art (MPEP 608.01(v)). See “Atom Standard”, a (seven page) Wikipedia article made of record 27 November 2009.
4. The examiner interprets **RSS** and **Atom** to be programming rules or guidelines, comparable to a book of grammar rules or guidelines for writing effective English. While the results of using **RSS** and **Atom** can be functional (just as the results of using English language

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symbols and Arabic numerals can be functional), **RSS and Atom** are themselves non-functional descriptive material and accordingly not given patentable weight.

5. The examiner interprets an **RSS/Atom feed/feed item** and a **RSS/Atom format compliant web feed** to be XML-based computer programs for syndicating content. (Para. [0007], [0054] and [0072] of the published application). **RSS/Atom feed/feed items and RSS/Atom format compliant web feeds** are not *per se* patentably distinct from any other XML-based computer program for syndicating content.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 11-13, 17-19, 21-25, 35-37, 42, 57-64 and 72-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At numerous places beginning at claim 1 line 10, "separate", RSS feed item, ad item, etc., is indefinite: "Separate" from what?.
8. Claims 1, 2, 11-13, 17-19, 21-25, 35-37, 42, 57-64 and 72-78 are provisionally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This is a provisional rejection because this rejection could have been made in the last Office action (for dependent claims 5, 6, 68 and 74) and therefore cannot now be made in this final rejection.¹ Applicant is put on notice that this rejection will be made if applicant continues prosecution before the primary examiner without overcoming this rejection (para. 12 below).
9. "RSS", "Real Simple Syndication" and "Atom" are indefinite. The examiner has interpreted these to be "names used in trade" (para. 3 above). Names used in trade are permissible in patent applications if:

¹ It is noted that claims 5, 6, 68 and 74 were rejected under 35 U.S.C. 112, second paragraph, so it might have been appropriate to make the present rejection non-provisional. The examiner did not do so because the subject claim language is now given a narrower interpretation (para. 3 and 4 herein).

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(A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(B) In this country, their meanings are well-known and satisfactorily defined in the literature.

Condition (A) or (B) must be met at the time of filing of the complete application (MPEP 608.01(v)).

10. Neither of these conditions is satisfied in the instant case. See para. 2 above and Atom Standard.

11. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe arbitrary rules or guidelines for writing computer programs in the XML language and, accordingly, the identification/description is indefinite.

12. This rejection can be overcome by deleting "RSS", "Real Simple Syndication" and "Atom" from the claims.

Claim Rejections - 35 USC § 102 and 35 USC § 103

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1, 2, 4, 11-13, 17-19, 23-25, 35-37, 42, 56-67, 69-73 and 75-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheth et al. (US006311194B1, hereafter "Sheth").

16. Sheth teaches (independent claims 1, 72 and 77) a method and system of generating information including targeted ads (col. 16 lines 37-55), the method (as represented by claim 1) comprising:

receiving, by at least one processor (*apparatus*, col. 5 lines 5-7, and *server cluster 510*, col. 16 line 56 to col. 17 line 9), a first syndicated content item (*XML assets*, col. 10 lines 43-45) to be distributed by an XML-based computer program for syndicating content (*an XML string*, col. 16 lines 37-40 and col. 14 lines 23-25), which reads on "for a Really Simple Syndication ('RSS') feed" (para. 5 above) provided by a syndicated content provider device (*syndicators*, col. 5 lines 34-40, and *server cluster 510*, col. 16 line 56 to col. 17 line 9), the first syndicated content item (Fig. 6) being an RSS feed item and including a first title, a first URL to a web page corresponding to the first syndicated content item, and a first description, the RSS feed being an RSS format compliant web feed (para. 5 above);

receiving, by at least one processor (as above), a first targeted ad item for the RSS feed (*an XML string with a URL reference to a semantically targeted advertisement*, col. 16 lines 37-44), the first targeted ad item being a separate RSS feed item (*a separate advertisement query*, col. 16 lines 12-14) and including a first targeted ad that has been provided by an advertiser (*an external advertisement provider*), a first targeted ad title for the targeted ad item, a first targeted ad URL to a web page corresponding to the first targeted ad, and a first targeted ad description (Fig. 6);

storing, on a computer storage device, the first syndicated content item and the first targeted ad item (col. 10 lines 15-16);

receiving a request for the RSS feed (col. 16 lines 12-14);

inserting, by at least one processor, the first targeted ad item at a location in the RSS feed (col. 16 lines 52-55), the first targeted ad item being inserted in response to a request for the RSS feed; and

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providing, by at least one processor and in response to the request for the RSS feed, the RSS feed, the first syndicated content item and the first targeted ad item (col. 16 lines 52-55).

17. The following claim language is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A):

“the location being adjacent to the first syndicated content item in the RSS feed”.

Printed matter is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

Sheth also teaches at the citations given above claims 2, 17-19, 23-25 (inherently, since the spec. does not explicitly and clearly define “first”, “second” and “different”), 42, 62-64 (where “ad mixer” is whatever mechanism is used to combine the delivered content and ad, col. 16 lines 52-55 and no patentable weight is given to the ad item location in the RSS feed), 73 and 78.

18. For independent claim 72 and dependent claims 11-13, 23-25, 63 and 64, Sheth also teaches dynamically generating targeted ads with content, which reads on “inserting the targeted ad item in the RSS feed”, “the targeted ad item being a separate RSS feed item”. (See Sheth: col. 1 line 67 to col. 2 line 3; col. 14 lines 41-48 and 56-59, where *additional results available in other context or domains* reads on an ad supplied dynamically with the requested results; col. 15 lines 26-30, where the *Sony Classics* logo in the upper right corner of each Fig. 13A-13C reads on ad; and col. 15 lines 51-56). Furthermore Sheth also teaches that ad items are mapped in the *WorldModel database of metadata* (col. 15 line 67 to col. 16 line 4 and col. 4 line 54 to col. 5 line 14), just as the content is. The ads are inserted dynamically in the feed with the content, not “embedded” in the content feed.
19. Sheth also teaches claims 11-13 (col. 13 lines 54-64 and col. 14 lines 23-25) and claims 35-37 (col. 9 lines 46-50).

20. The following claims add only non-functional descriptive material (printed matter) and were not given patentable weight (para. 15 above): 18, 57-61 and 74-76 (the arrangement of text is a non-functional artistic or formatting detail).

21. Claims 1, 2, 4, 11-13, 17-19, 23-25, 35-37, 42, 56-67, 69-73 and 75-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheth et al. (US006311194B1, hereafter

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“Sheth”) in view of *RSS Advertising* (archived weblog made of record herewith). Sheth does not teach the targeted ad item location in the RSS feed being adjacent to the syndicated content item. *RSS Advertising* teaches (p. 1 of 8) the targeted ad item location in the RSS feed being adjacent to the syndicated content item. Because the ad item pertains to the content item, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of *RSS Advertising* to those of Sheth.

22. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because it is simple common sense to put related things together..

23. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheth, or alternatively, Sheth in view of *RSS Advertising*, and further in view of official notice. Sheth does not teach targeting ads by geography. This was a common means of targeting ads at the time of the instant invention. For example, ads for any certain merchant are only distributed in the regions where the merchant does business. Official notice of this common knowledge or fact well known in the art was taken in the Office action mailed 29 September 2008 (para. 13). Since applicant failed to traverse the examiner’s assertion (para. 20 of the Office action mailed 12 March 2009), it is taken to be admitted prior art (MPEP 2144.03.C). Also see para. 26 below.

Response to Arguments

24. Applicant's arguments filed with an amendment on 26 February 2010 have been fully considered in the revised rejection.

Search for Allowable Matter

25. The examiner has searched this application for potentially allowable matter (i.e., a feature of the disclosed invention that would overcome a rejection of record) and regrets to report that none was found. In particular, the examiner performed a search of the non-patent literature and a patent document search of targeting ads by geography (para. 23 above). The searches are being made of record herewith.

26. The NPL search identified *RSS Advertising* (para. 21 and 22 above), which illustrates the addition of an ad item near a content item in an RSS feed. The geographic targeting search identified Gerszberg et al. (US006044403A), which teaches offering personalized news

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delivery with ads targeted by geographic location. Since Sheth also teaches offering news feeds and targeted advertising, the addition of the teachings of Gerszberg to those of Sheth would be obvious.

27. If applicant believes any one or more features of the instant application are potentially patentable, it would behoove the applicant to clearly identify those features by an after-final filing under 37 CFR 1.116.

Conclusion

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
29. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
31. The examiner's supervisor, Lynda Jasmin, can be reached on 571-272-6782.
32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

33. **AFTER FINAL INTERVIEW PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. **The examiner will grant an interview after final only when applicant files an interview request (form PTOL-413A)** containing compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration..
34. Applicant may have after final arguments considered and amendments entered by filing an RCE.
35. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

6 June 2010

/Donald L. Champagne/
Primary Examiner, Art Unit 3688